

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES, ERIC JOHN NELSON,
and JOHN MATTHEW SANTOSUOSO

Appeal 2007-0556
Application 10/178,439¹
Technology Center 2600

Decided: June 26, 2007

Before: HOWARD B. BLANKENSHIP, JEAN R. HOMERE and
JAY P. LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal from a rejection of claims 1 to 9 and 12 to 19 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

¹ Application filed August 7, 2000. The real party in interest IBM Corporation.

Appellants' invention relates to an improvement to a satellite radio. More specifically, it provides an apparatus and method for viewing information about songs or other programs that are playing on another channel while listening to the songs on a first channel. In the words of the Appellants:

According to the preferred embodiments, a satellite radio receiver includes a display that displays information regarding one or more channels that are not currently being listened to. For a music channel, this information may include the name of the artist, the song title, time left in the song, etc. For a news channel, this information may include the news currently being discussed, the name of the news program, the time remaining, etc. For a sports channel, this information may include the name of the channel, a description of the sporting event, the time remaining, etc. The preferred embodiments include different ways to select which channels are "favorites" and therefore displayed on the display. One way is to select one or more channels that are assigned to preset buttons on the radio receiver. Another way is to keep track of which channels are most frequently listened to, and to display information regarding those channels. The preferred embodiments extend to any and all mechanisms for displaying information regarding one or more channels that are not currently being listened to. (Specification 3).

Claims 1 -3 are exemplary:

1. A satellite radio receiver comprising:
 - a satellite radio processor that receives a plurality of digital satellite radio signals on a plurality of channels, each digital satellite radio signal including a radio program and identifying information related to the radio program, the satellite radio processor outputting audio information corresponding to the radio program in one of the digital satellite radio signals that correspond to a selected channel; and
 - a display within the satellite radio receiver that is coupled to the satellite radio processor and that displays information regarding at least one channel that is not the selected channel, wherein the displayed information is

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derived from the identifying information for the at least one channel that is not the selected channel.

2. The satellite radio receiver of claim 1 further comprising a memory coupled to the satellite radio processor, the memory containing at least one channel preset.
3. The satellite radio receiver of claim 2 wherein the memory further contains a list of favorite channels, wherein the at least one channel that is not the selected channel is in the list of favorite channels.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Schwob	US 5,152,012	Sep. 29, 1992
Shigematsu	US 5,416,774	May 16, 1995]
Tuoriniemi	US 5,978,689	Nov. 2, 1999
Logan	US 6,199,076 B1	Mar. 6, 2001

Grouping of Claims:

Appellants group the claims as follows:

Claims 1, 2, 6, 12, and 16 are grouped, and stand and fall together based on claim 1.

Claims 3 and 13 are grouped, and stand and fall together based on claim 3.

Claims 4 and 14 are grouped, and stand and fall together based on claim 4.

Claims 5 and 15 are grouped, and stand and fall together based on claim 5.

Claims 7 and 17 are grouped, and stand and fall together based on claim 7.

Claims 8 and 18 are grouped, and stand and fall together based on claim 8.

Claims 9 and 19 are grouped, and stand and fall together based on claim 9.

(Brief 4)

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Appellants contend that the claimed subject matter is not rendered obvious by the combination of Tuoriniemi, Logan, and Schwab, with Shigematsu, for reasons to be discussed more fully below. The Examiner contends that each of the three groups of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Rejection of April 15, 2004, the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).²

We will affirm-in-part the rejections.

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims 1 to 9 and 12 to 19 under 35 U.S.C. § 103(a). The issue turns on whether the references Tuoriniemi and Schwab, augmented by teachings from Shigematsu and Logan, teach the claimed invention, and whether the teachings can be properly combined under 35 U.S.C. 103(a).

² Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

Findings with respect to the rejection of claims 1, 2 to 6, 12 to 15, and 16 under 35 U.S.C. § 103(a).

1. Appellants' claims are directed to a satellite radio receiver and method including a radio processor that receives a plurality of channels, each channel having program material and related identifying information. The radio plays an output from a selected channel, while displaying information regarding at least one other non-selected channel. (Claim 1, Figure 4).
2. The reference Tuoriniemi teaches a receiving device that receives voice communications (telephone) and audio radio signals from a digital satellite system. (Tuoriniemi, col. 13, ll. 3 – 39). The limitations concerning selected and non-selected channels can be read on the telephone channel and the radio channel of Tuoriniemi. (Col 5, l. 60 *ff*). The Examiner has cited Logan to teach the display showing indicia on the non-selected channel (Rejection filed Apr. 15, 2004, 3, top), but it should be noted that the Tuoriniemi device itself contains a display, #56. When the user is using the radio channel and a phone call comes in, the display indicates "Mom Calling" (Tuoriniemi, col 11, bottom line); and when the user is performing telephone operations (Tuoriniemi, col 11, ll. 40+), he can scan radio stations, receiving information derived from the identify information for the non-selected (radio) channel. We notice from column 12, line 8 *ff*, that the information

includes program information (e.g. Howard Stern, Performer K D Lang).

3. Examiner regards Schwob as teaching “a radio broadcast receiver with a significant amount of data that is displayed but was not selected by the user for display”. (Answer, page 4).
Schwob teaches a broadcast receiver with a display 8 (Figure 15). The receiver is capable of selecting stations nationwide from a pre-stored list (col. 7, l. 44) based on varied criteria. The teaching that Schwob adds to Tuoriniemi is that of listening to one channel while the display indicates information about another channel. Regard, for example, Figure 15: While the user is listening to one channel, information about another channel (e.g. its music type, its geographic position, its call letters) (col. 8, middle) is cycled onto display 8’ (col. 8, l. 7). This information allows the user to switch to that “soon-to-be-selected” channel if he is tired of the programming on the currently selected channel. The rejection indicates that it would be obvious to combine the teaching of downloading this identifying information from the satellite DAB signals, as taught by Tuoriniemi, rather than using those from a stored database, as demonstrated in Schwob.
4. Claim 2, Claim 3, Claim 4 (and Claims 13, 14): We note in Schwob a memory #3 containing the preset channels with attributes selectable by the user (e.g. classical, country, and western). When the user selects classical, a number of stations with that attribute display on the screen (col. 8, top). One is

then selected out of their non-selected state. We can read “classical” as the list of favorite channels in Schwob. We also note in Schwob, Figure 15, a set of “Preset Stations” 1 to 6, as well as a “Classical” button. We find that either the “Classical” or a preset channel could be part of the list of a user’s favorites.

5. Shigematsu, it is noted, also teaches preset channels stored in memory (col. 7, middle) in a digital broadcast receiver capable of audio and TV.
6. Claims 5, 15: We do not find a basis for the “channels listened to most frequently” in Schwob or the other references.

Findings with respect to claims 7, 8, 9, 17, 18 and 19:

7. Claims 7, 17, 9, 19: A careful reading of these dependent claims reveals that they all address “the displayed information”, the antecedent basis for which is the radio program in claim 1 or 12 that corresponds to the non-selected channel. As discussed in Findings of Fact #2 or #3, it was demonstrated that the elements of Claim 1 were obvious over Tuoriniemi in combination with Schwob. Tuoriniemi teaches that the Digital Audio Broadcasting (DAB) or Radio Data Systems (RDS) include “music, name of performer” (col. 13, middle) and artists, song title, and title for the radio program. (col., 12, top: Howard Stern, K D Lang). Schwob adds the teaching of listening to one channel while viewing the information concerning another channel, as described in Finding of Fact #3.

The Examiner combined these teachings, for which we do not find error.

8. Claims 8, 18: Logan, in a computer based audio programming system, teaches in column 12, bottom, the display of the time remaining in a segment being listened to in a program. The purpose of the time indication is to help the user decide if he would like to continue listening, or jump to another segment in the program. The Examiner indicates that it would be obvious to add this feature to the combination of Tuoriniemi and Schwob (et al) as claimed. In addition, we note that claims 8 and 18 are distinguished by the nature of the material that is displayed, and not by any claimed structure or function that generates the material being displayed, that is, the time remaining for the radio program.

PRINCIPLES OF LAW

On appeal, Appellants bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We note our reviewing court has recently reaffirmed that:

an implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of

references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient ... In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368, 80 USPQ2d 1641, 1651 (Fed. Cir. 2006) (emphasis in original).

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *see also In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 1325, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004). Furthermore, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)

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(quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

With regard to the issue of whether it is obvious to use a more modern technology in substitution for an older one, we take guidance from the recent *Leapfrog Enterprises, Inc v. Fisher Price, Inc. and Mattel, Inc.*:

“Thus we bear in mind that the goal of the clam 25 device was to allow a child to press a switch associated with a single letter in a word and hear the sound of the letter as it is used in that word. ... Accommodating a prior art mechanical device that accomplishes that goal to modern electronics would have been reasonably obvious to one of ordinary skill in designing children’s learning devices. Applying modern electronics to older mechanical devices has been commonplace in recent years.” *Leapfrog Enterprises, Inc v. Fisher Price, Inc. and Mattel, Inc.*, --- F.3d ----, 2007 WL 1345333, C.A.Fed. (Del.), May 09, 2007 (No. 06-1402.)

However, our reviewing court has held that nonfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862,1864 (Fed. Cir. 2004). Cf. *In re Gulack*, 703 F.2d 138 1, 1385,217 USPQ 401,404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

ANALYSIS

Appellants contend that Examiner erred in rejecting claims 1 to 9, and 12 to 19 under 35 U.S.C. 103(a). Reviewing the Findings of Facts cited above, we find that the Tuoriniemi reference teaches a satellite radio with a

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display capable of a dual channel operation, telephone voice, and radio. (Finding #2). The radio section contains program material and identifying information related to the program material. While listening in one of these channels, interruptions in the form of messages and alerts from the identifying information concerning the other channel are displayed (and synthesized). (Finding #2).

Schwob teaches a conventional (non-satellite) radio with a display that, while the listener is listening to one channel, displays information about another non-selected channel (Finding #3). Schwob also teaches presets and lists of favorite channels (Finding #4) relating to claims 4 and 14. Modernizing the radio for satellite radio transmission is considered an obvious modification (*See Leapfrog* above). Combining the teachings from the same field of endeavor as taught by Tuoriniemi and Schwob to support a rejection under 35 U.S.C. 103(a) is not an error (*See Bigio* and *KSR* above). The rejection of Claims 7, 8, 9 and 17, 18 and 19 (See Finding #7 above) is not in error for reasons discussed above, namely the teachings of the title of the audio program and the artist's name and song title is shown in the combination of Tuoriniemi and Schwob, when combined as indicated in the rejection and Findings of Fact. These items are also deemed to contain non-functional descriptive material (see MPEP 2106.01), which material was not given patentable weight in distinguishing over Tuoriniemi and Schwob.

The subject matter of claims 5 and 15 is not demonstrated within the cited prior art in the context of the claimed invention. (See Findings of Fact #6 and #8.)

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 5 and 15. The rejection of those claims is reversed. The rejection of all the other claims 1 to 4, 6 to 9, 12 to 14, 16, 17, 18 and 19 is affirmed³.

OTHER ISSUES

Examiner is reminded that USPTO procedures require that rejections be fully repeated in the Examiner's Answer, and that the Board not be referenced to other actions (e.g. Final Rejections) in the file. See MPEP 1207.02. In the interest of reasonable dispatch of this appeal the procedure was overlooked; however in future appeals an administrative remand would be appropriate.

DECISION

The rejection of claims 5 and 15 is reversed. The rejection of claims 1 to 4, 6 to 9, 12 to 14, 16, 17, 18 and 19 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

³ Examiner's comment on page 3 of the Answer concerning claims 3 to 5, and 13 to 15 notwithstanding.

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AFFIRMED-IN-PART

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